

REMARKS

1. *Informalities*

Substitute Specification. Applicant is submitting a substitute specification to replace the one originally submitted. Several insignificant changes have been made to the specification to both clarify certain concepts and information, as well as to correct various typographical errors found therein. Applicant submits that no new matter is presented, and that the replacement specification conforms to and is submitted pursuant to 37 C.F.R. § 1.125.

Claim cancellation. Claim 3 has been cancelled from the application.

Statement of Substance of Interview. An interview with the Examiner was conducted on January 28, 2001 in regards to the above-referenced case. The amendments and remarks provided herein are reflective of the discussion the undersigned had with the Examiner in an effort to resolve the objections and rejections presently interfering with the allowance of the claims. In the interview, an agreement was reached that Applicant would amend the claims to include the limitation of the scope of the invention to satisfy 35 U.S.C. § 112, first paragraph. Also, an agreement was reached that if applicant chose to amend the claims to recite functional language, that such language would be properly supported in the specification. Furthermore, Applicant agreed to that further limitations on the composition of claims should be provided, such as the inclusion of Xeronine and its function. Still further, Applicant is not including the term "normal" in its claim amendments as this is merely a relative term. Finally, it was suggested that applicant could amend the claims to cover a method of treating a specific disorder or skin condition. However, applicant has chosen to forego such an amendment at this time.

2. *Claim Rejections - 35 U.S.C. § 112, first paragraph*

Claims 1-26 stand rejected under 35 U.S.C. § 112, first paragraph as the scope of the

claims is allegedly inconsistent with the specification disclosure. In response, Applicant submits that the Specification has been amended to clarify that any part of the Indian Mulberry plant may be used to obtain the appreciable amount of *Morinda citrifolia* used in the skin care toner compositions of the present invention. No new matter is being presented as the specification originally supported such basis. Applicant amended the specification to simply clarify this point. As much, Applicant submits that proper support for the language found in claims 1-26 pertaining to the phrase “*Morinda citrifolia*” is properly supported in the written description of the Specification.

3. Claim Rejections - 35 U.S.C. § 102

Claims 1-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,288,491 to Moniz (hereinafter referred to as “Moniz,” or “the ‘491 patent”).

In response, claim 1 has been amended to recite a topical toner comprising specific elements of Proxeronine and Proxeronase, two building blocks to Xeronine, a nutrient found to improve and enhance the vitality of cells. Moreover, claim 1 was amended to include a suitable cosmetic carrier. This amendment serves to limit and narrow the composition as required by the Examiner in the Interview. Moniz does not disclose a cosmetic topical skin toner, nor specifically a topical cosmetic skin toner comprising these two elements combined with a suitable cosmetic carrier.

Moreover, Applicant submits that Moniz does not disclose nor teach incorporation of *Morinda citrifolia*, or Noni, specifically into a cosmetic skin care product, and particularly a cosmetic skin care toner, as does the composition of claim 2 of the present invention. Moniz’

primary focus is on the medicinal benefits allegedly derived from *ingesting* Noni into the body. Brief mention is made to topical applications, but these too are focused on alleviating pain and suffering of burns, scratches, cuts, etc. of an individual, and not to cosmetic skin care products.

Anticipation under 35 U.S.C. § 102 “requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention.” See *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (Fed. Cir. 2000). In other words, “for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review.” See *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998). Thus, as the strictures of patent law, and particularly 35 U.S.C. § 102, require each and every element of the claim at issue be present in the prior art for the prior art to anticipate that particular claim, it cannot be said that Moniz anticipates independent claim 1 of the present invention. Nowhere in the Moniz reference does it teach or suggest, either expressly or inherently, that Proxeronine and Proxeronase are combined with a cosmetically suitable carrier to come up with a topical skin care toner. In addition, Moniz does not teach that Indian Mulberry or Noni extract may be used as an active ingredient or vehicle in a skin toner for benefitting and caring for the skin as does claim 2 of the present invention. Moreover, Moniz does not teach the use of a cosmetically suitable carrier, wherein the carrier and the *Morinda citrifolia* are combined to form a cosmetic skin care toner.

As claims 2-17 place further limitations on otherwise allowable subject matter of claim 1, Applicant submits that these claims are not anticipated by Moniz, but present allowable subject matter.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. JP200095663A to Kondo (hereinafter referred to as “Kondo”). In response, Applicant submits that in light of the amendment to independent claim 1 to recite the elements of Proxeronine and Proxeronase, and the limitation in claim 2 of *Morinda citrifolia* being present in an amount between about 10-80 percent by weight of the total composition, that Kondo no longer anticipates claims 1 or 2 of the present invention. Kondo makes no mention of Proxeronine and Proxeronase in the body or in the composition itself. Kondo also specifically states that the percent of extract from the Indian Mulberry plant is 4.8% by weight, thus outside the range of the Applicant’s composition in claim 2.

4. Claim Rejection – 35 U.S.C. § 103

Claims 3-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kondo in view of United States Patent No. 5,472,699 to Duffy (hereinafter referred to as “Duffy” or “the ‘699 reference”).

In response, claims 1-26 have been amended. Applicant submits that neither Kondo nor Duffy disclose nor teach, either expressly or inherently, a composition containing the building blocks, Proxeronine and Proxeronase, to actively release Xeronine from the composition itself and the body, wherein Xeronine is a nutrient having special abilities to revitalize, replenish, and contribute to the overall vitality of the cells of the skin. See *Specification of Present Invention*, pg. 21-22. Specifically, Xeronine is capable of protecting and keeping the shape and suppleness of protein molecules so that they may be able to pass through the cell walls and be used to form healthy tissue. In addition, Xeronine assists in enlarging the membrane pores of the cells allowing for larger chains of peptides (amino acids or proteins) to be admitted into the cell, as

well as assisting in enlarging the pores to allow better absorption of various nutrients. *Id.*

Moreover, Kondo states that the purpose or benefit of its specific composition is to assist in the prevention of melanism (darkening) of the skin, and particularly the whitening of the skin. Kondo does not disclose any specific benefits of *Morinda citrifolia* itself, but only discloses *Morinda citrifolia* in a vague and general sense. One ordinarily skilled in the art would not look to the Kondo reference to arrive at the toner composition of the present invention.

CONCLUSION

In light of the foregoing amendments and remarks, applicant respectfully submits that all rejections and objections have been dealt with favorably and that the application is now in a condition for allowance. Action to this end is respectfully requested.

If any impediments to the allowance of this application remain after entry of these amendments and consideration of these remarks, the Examiner is invited to telephone the undersigned.

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Respectfully Submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Please see the enclosed redline version of the amended specification showing all changes made to the specification in the amendments.

In the Claims:

1. — A topical cosmetic skin toner composition comprising:

— Morinda Citrifolia designed to be spread on the skin to hydrate and balance pH levels in
said skin, said composition comprising:

Proxeronine present in an amount between about 0.001-80 percent by weight;

a quantity of Proxeronase to activate the release of Xeronine from said Proxeronine, said

Proxeronase also capable of activating the release of Xeronine from any

Proxeronine present in said skin, said Xeronine capable of enhancing and

improving cellular vitality in said skin; and

a cosmetically suitable carrier agent.

2. — The topical cosmetic skin toner composition of claim 1, wherein said Proxeronase

is in processed Morinda citrifolia present in an amount between about 0.1-80 10-80 percent by

weight. wherein said mMorinda citrifolia is present in an amount between about 0.1-5 percent
by weight.

3. — The cosmetic skin toner composition of claim 1, wherein said morinda citrifolia is

present in an amount between about 5-10 percent by weight.

Claim 3 has been cancelled.

4. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 10-15 percent by weight.

5. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 15-20 percent by weight.

6. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 20-25 percent by weight.

7. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 25-30 percent by weight.

8. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 30-35 percent by weight.

9. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 35-40 percent by weight.

10. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 40-45 percent by weight.

11. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 45-50 percent by weight.

12. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 50-55 percent by weight.

13. The topical cosmetic skin toner composition of claim 1, wherein said *mMorinda citrifolia* is present in an amount between about 55-60 percent by weight.

14. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 60-65 percent by weight.

15. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 65-70 percent by weight.

16. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 70-75 percent by weight.

17. The topical cosmetic skin toner composition of claim ± 2 , wherein said *mMorinda citrifolia* is present in an amount between about 75-80 percent by weight.

18. The topical cosmetic skin toner composition of claim 1, further comprising water

present in an amount between about 20-80 percent by weight.

19. The topical cosmetic skin toner composition of claim 1, further comprising ingredients selected from the group consisting of glycerin, alcohol denatured, butylene glycol, sodium chloride, dipotassium phosphate, sodium citrate, panthenol (pro-vitamin B5), diazolidinyl urea, PPG-26-Buteth-26, benzophenone-4, citric acid, disodium EDTA, potassium phosphate, PEG-40 hydrogenated castor extract, capryloyl salicylic acid (beta-hydroxy acid), fragrance, PEG-115M, cabbage rose water, FD & C Red No. 4, and D&C Red No. 33.

20. The topical cosmetic skin toner composition of claim 1, further comprising ingredients selected from the group consisting of alcohol denatured, butylene glycol, glycerin, silica dimethyl silylate, zinc oxide, propylene glycol, PEG-60 hydrogenated castor extract, methylparaben, lactic acid, grapefruit extract, fragrance, menthoxypropanediol, hexylene glycol, and witch hazel.

21. The topical cosmetic skin toner composition of claim 1, further comprising ingredients selected from the group consisting of SD alcohol 40, witch hazel distillate, PEG-40, hydrogenated castor oil, fragrance, aloe vera gel, allantoin, menthyl lactate, sorbitol, sodium lactate, proline, sodium PCA, hydrolyzed collagen, FD&C Blue No. 1, and FD&C Yellow No. 5.

22. The topical cosmetic skin toner composition of claim 1, further comprising ingredients selected from the group consisting of glycerin, PEG-8, PEG-40, hydrogenated castor

oil, polyaminopropyl biguanide, panthenol, niacinamide, aloe barbadensis gel, matricaria (Chamomilla Recutita) extract, propylene glycol, polyquaternium-10, ethoxydiglycol, fragrance, EDTA, sodium hydroxide, and methylparaben.

23. The topical cosmetic skin toner composition of claim 1, further comprising ingredients selected from the group consisting of SD alcohol 40-B, dipropylene glycol, witch hazel (Hamamelis Virfiniana) distillate, hops (Humulus lupulus) extract, rosemary (Rosmarinus Officinalis) extract, swertia japonica extract, tocopheryl acetate (vitamin E Acetate), panthenol, aloe barbadensis extract, pyridoxine HCL, farnesol, salicylic acid, menthol, glycerin, fragrance, butylene glycol, and sodium hydroxide.

24. The topical cosmetic skin toner composition of claim 1, further comprising ingredients selected from the group consisting of SD alcohol 40-B, witch hazel distillate, menthol, aloe barbadensis extract, glycerin, diglycerin, eucalyptus globulus oil, fragrance, butylene glycol, PG, Ext. Violet 2, and green 5.

25. A topical cosmetic ~~balancing~~ skin toner composition comprising:
Morinda Citrifolia oil present in an amount between about 0.1-80 ~~0.1-80~~ 10-80 percent by weight; and
~~at least one ingredient capable of restoring normal pH levels to~~
a cosmetically suitable carrier agent, said composition designed to hydrate and balance pH levels
in the skin.

26. A topical cosmetic hydratingbalancing skin toner composition comprising:
Morinda Citrifolia fruit juice present in an amount between about 0.1-8010-80 percent
by weight; and

~~at least one ingredient capable of providing hydration to the skin.~~

a cosmetically suitable carrier, said composition operating to balance pH levels in the
skin.

27. A topical cosmetic balancing skin toner composition comprising:
Morinda citrifolia oil present in an amount between about 10-80 percent by weight;
a balancing agent; and
a cosmetically suitable carrier, said composition operating to balance pH levels in the
skin.

28. A topical cosmetic hydrating skin toner composition comprising:
Morinda citrifolia fruit juice present in an amount between about 10-80 percent by
weight;
a hydrating agent; and
a cosmetically suitable carrier, composition operating to hydrate the skin.

29. A topical cosmetic hydrating skin toner composition comprising:
Morinda Citrifolia oil present in an amount between about 10-80 percent by weight;

a hydrating agent; and

a cosmetically suitable carrier, composition operating to hydrate the skin.

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